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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/775,402

02/10/2004

Craig M. Housworth

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27581 7590 01/18/2007  
MEDTRONIC, INC.  
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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT

PAPER NUMBER

3766

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/775,402	Applicant(s) HOUSWORTH ET AL.	
	Examiner Kennedy Schaetzle	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

4. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Snell (Pat. No. 6,263,245).

Regarding claim 1, the examiner considers unit 110/230 to represent the recited module, with Fig. 2 showing the housing, Fig. 3 explicitly showing the telemetry circuit (400, 440, etc.), and the combination of Figs. 2 and 3 showing the recited connector (see the area generally referenced by the dotted line in Fig. 2 and the communications interface of Fig. 3). Although not explicitly set forth in claim 1, the implantable medical device and clinical instrument are shown by elements 120 and 150/240.

Regarding claim 9, the examiner considers the ECG circuit 474/476 to be an additional modular sensor that can be detachably coupled to the clinical instrument.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Snell.

7. Regarding claim 2, the examiner considers the requisite power source in unit 100 to be connected to the portable unit 110 when the two units are engaged by virtue of the mechanical connection of one housing to the other. In any event, the examiner took Official Notice in the previous Office Action that connection systems such as USB and Firewire (note col. 6, lines 53-60) allow for plug-in peripheral devices to be powered and/or recharged by primary units that typically plug into a buildings electrical power system at the wall outlet. Such arrangements allow for convenient recharging and/or conserve the portable device's battery power when reliance on autonomous power is unnecessary. As this notice has not been traversed, the feature or limitation is now considered admitted prior art.

***Response to Arguments***

8. Applicant's arguments filed October 27, 2006 have been fully considered but they are not persuasive.

The applicants argue that Snell merely discloses a portable interrogation device that can be interfaced with a data processing device and not with a clinical instrument. It is unclear how the applicants can make such an assertion when clearly element 150/240 is described by Snell as being a programmer/analyzer capable of displaying the received data for analysis by the physician (see the text abridging cols. 6 and 7). On its face, a device that displays transmitted data from an implantable unit is in the very least a clinical monitoring instrument. The burden of proof is on the applicants to show otherwise. Furthermore, the claim 1 is not drawn to the combination of a programmer module and a clinical instrument. The clinical instrument is only referred to in a functional sense as a matter of intended use for the programmer module.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 571 272-4954. The examiner can normally be reached on M-F from 9:30 -6:00.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: the status of the CIP mentioned on page 1 of the specification must be updated.

Appropriate correction is required.

### ***Election/Restrictions***

2. Newly submitted claims 10-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 10-16 are drawn to the subcombination of the clinical instrument. The combination claims do not require a clinical instrument with the central processing system details of the subcombination. The subcombination has utility by itself as an external defibrillator, or any other therapy/monitoring device that contains a receptacle and a central processing system. The reference to the programmer module in claim 10 is only in the functional sense and only represents intended use for the clinical instrument. As admitted by the applicant, the clinical instrument can encompass a wide variety of different systems and therefore would involve a recognized divergent search.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –


(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3766

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on M-F at 571 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJS  
January 8, 2007



KENNEDY SCHAETZLE  
PRIMARY EXAMINER